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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,179	03/27/2001	Richard Francis Russell	2000-0020.00	1247
21972	7590	10/11/2005		
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			EXAMINER LESNIEWSKI, VICTOR D	
			ART UNIT 2152	PAPER NUMBER
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/818,179

Applicant(s)

RUSSELL ET AL.

Examiner

Victor Lesniewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The amendment filed 7/18/2005 has been placed of record in the file.
2. Claims 1-23 are now pending.
3. The applicant's arguments with respect to claims 1-23 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

### ***Claim Rejections***

4. Claims 1-10, 12, 17, 18, and 20-23 remain rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki (U.S. Patent Number 6,785,727) as stated in the previous action dated 4/15/2005. Claims 11 and 13-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki as stated in the previous action dated 4/15/2005. Claim 19 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki in view of Official Notice as stated in the previous action dated 4/15/2005.

### ***Response to Arguments***

5. In the remarks, the applicant has argued:

- <Argument 1>

Yamazaki does not disclose the features of claim 1 because he does not disclose "allowing only one of the users to own the data channel at any single point in time" as recited in claim 1.

- <Argument 2>

Yamazaki does not disclose the features of claim 1 because he does not disclose “instructing the host-based networking hardware to accept information on the data channel only from the user that owns the data channel” as recited in claim 1.

- <Argument 3>

Yamazaki does not disclose the features of claim 2 because he does not disclose “wherein the host-based networking hardware disregards all said information received on the data channel from any of the users that do not own the data channel” as recited in claim 2.

- <Argument 4>

Yamazaki does not disclose the features of claim 5 because he does not disclose “wherein the status response indicates the user that owns the data channel” as recited in claim 5.

- <Argument 5>

Yamazaki does not disclose the features of claim 8 because he does not disclose “wherein a user that does not own the data channel can acquire the data channel by sending a connect signal on the command channel to the host-based networking hardware” as recited in claim 8.

- <Argument 6>

Yamazaki does not disclose the features of claim 12 because he does not disclose “the host-based networking hardware discarding any said communication frame that does not have an expected said sequence number” as recited in claim 12.

- <Argument 7>

Yamazaki does not disclose the features of claim 13 because he does not disclose “the host-based networking hardware sends an acknowledgement including the frame number of the last successfully received communication frame to the user that owns the data channel” as recited in claim 13.

- <Argument 8>

The rejection of claims 14-16 is based on hindsight.

6. Before discussing the arguments in detail, it is noted that the applicant has set forth a detailed definition of host-based networking hardware with references to his specification. However, this definition is not a limitation of the claims. Yamazaki’s system includes networking hardware present on the printer to control the processing of jobs. It is seen that his hardware is host-based as the system utilizes a separate host computer connected over the LAN so that a user may communicate with and control the printer. The applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. In response to argument 1, Yamazaki does disclose the features as recited in claim 1. The previous line citation, column 8, lines 28-34, shows how a user can set a reserved time zone during which he will have control of the printer. It is maintained that this satisfies the limitation of owning the data channel as recited in claim 1. The applicant has stated that this printer reservation does not satisfy the limitation because Yamazaki’s system allows a job to be processed from another user as seen in figure 21. However, it is noted that this function of

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Yamazaki's system does not change the ownership of the channel or allow for multiple owners.

The printer is still reserved by only one user as is seen in figure 21.

8. In response to argument 2, Yamazaki does disclose the features as recited in claim 1. The previous line citation, column 10, lines 34-36, clearly shows the rejection of a job that is not a job of the owner. It is maintained that this satisfies the limitation of accepting information only from the owner as recited in claim 1. As discussed in relation to argument 1, the user cites Yamazaki's ability to process the job of another user while the printer is reserved by a first user. However, this is an alternate embodiment of Yamazaki's system. The owner must actively set the printer to allow the processing of other jobs during his reservation and just because Yamazaki's system offers this alternate functionality does not mean that his system does not satisfy the limitation in question. Clearly, Yamazaki's owner is enabled to own the printer so that no jobs from additional users are processed during his reservation. For clarification the applicant is directed to figure 19, item 1905 and column 11, lines 1-12.

9. In response to argument 3, Yamazaki does disclose the features as recited in claim 2. This argument is similar to argument 2 and the applicant is directed to paragraph 8 above. Again, for clarification the applicant is directed to figure 19, item 1905 and column 11, lines 1-12.

10. In response to argument 4, Yamazaki does disclose the features as recited in claim 5. The previous line citation to figure 16 shows an indication of the owner. The applicant has stated that this designation refers to the owner of the document and not the owner of the channel. However, it is noted that during a reserved time zone in which only the reserver's documents are processed, the owner of the document and the owner of the channel are the same.

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11. In response to argument 5, Yamazaki does disclose the features as recited in claim 8. The previous line citation, column 8, lines 28-34, shows how a user can set a reserved time zone during which he will have control of the printer. It is maintained that this functionality satisfies the limitation of acquiring the data channel as the user who sets the reserved time zone becomes the owner at that time. Furthermore, the applicant has not specifically discussed how the limitation in question is seen to be distinct from Yamazaki. Thus it is noted that this argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claim patentably distinguishes it from the reference.

12. In response to argument 6, Yamazaki does disclose the features as recited in claim 12. The applicant has stated that the discarding step is performed by the PDL translator 1112 which is part of printer 1000 in Yamazaki's system. It is not understood why the applicant sees this as contradictory to the claim language. The applicant has asserted that the discarding is not done by "host-based networking hardware," but it can be seen that the PDL translator is part of the networking hardware present on printer 1000. For further discussion on host-based networking hardware the applicant is directed to paragraph 6 above.

13. In response to argument 7, Yamazaki does disclose the features as recited in claim 13. The limitation in question was rejected as being obvious over Yamazaki. As previously explained the ability to send acknowledgements in a system such as Yamazaki's is considered an obvious variation. In terms of the acknowledgement "including the frame number of a last successfully received communication frame," it is pointed out that the purpose of an acknowledgement message is to acknowledge that information has been received successfully.

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The applicant is further directed to the additional statements after the line citations in the rejection of claim 13 on page 8 of the previous action dated 4/15/2005.

14. In response to argument 8, it is maintained that the rejection of claims 14-16 is not based on hindsight. First, it is noted that the rejection does not rely upon Williams et al, which was only cited as being considered pertinent prior art. Second, just as the acknowledgement, the timeout in a system such as Yamazaki's is considered an obvious variation. Regarding hindsight, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It is maintained that usage of a timeout in networking systems was well within the level of ordinary skill at the time the claimed invention was made and thus claims 14-16 have been rejected as being obvious over Yamazaki.

15. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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